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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

OUELLETTE, JONATHAN P

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 01/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/460,806

Applicant(s)

LEE, EUGENE M.

Examiner

Jonathan Ouellette

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 11-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 11-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Claims 8-10 have been cancelled, Claims 25-32 have been added. Claims 1-7 and 11-32 are now pending in application 09/460,806.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
3. **Claims 1, 4-7, 11-13, 15-19, 21, 22, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown, Pinnisi & Michaels, PC (www.lightlink.com/bbm, retrieved from Internet Archive Wayback Machine <www.archive.org>, date range: 2/24/1998-2/18/1999) in view of InventNet (www.inventnet.com, retrieved from Internet Archive WayBack Machine <www.archive.org>, date range: 12/3/1998-2/9/1999).**
4. As per independent Claim 1, BPM discloses a computer implemented method for transacting an intellectual property service in connection with the filing of documents and/or payment of fees for intellectual property matters, the method comprising: providing a user with information representative of one or more intellectual property matters (form of intellectual property protection); providing a user with information

representative of one or more intellectual property services (search, filing, maintenance) corresponding to the one or more particular intellectual property matters and one or more fees associated therewith wherein the fees include one or more of: official fees, and service fees (pgs. 10-20).

5. BPM fails to expressly disclose automating the disclosed step: determining one or more intellectual property matters; providing, responsive to the determination, a user with information representative of one or more intellectual property services corresponding to the one or more particular intellectual property matters, and selecting, responsive to the user, one or more of the intellectual property services for one or more of the intellectual property matters, and initiating, responsive to the user, performance of the selected one or more intellectual property services for one or more of the intellectual property matters.
6. However, BPM discloses an intellectual property information service wherein the website outlines the fees associated with the application process (pgs.10-12) along with an outline of the steps required in the application process, to include an initial consultation, search, and application completion and filing (pgs. 10-12) - and it would have been obvious to one of ordinary skill in the art at the time the invention was made to simple automate this process by completing the outlined steps electronically, to include an electronic consultation (wherein fees and schedules would be reviewed and agreed upon) and by electronically supplying the necessary forms (for completion of the intellectual property application process.
7. Furthermore, It was known at the time the invention was made, that merely providing an automatic means to replace a manual activity which accomplishes the same result is not

sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example, simply automating the step of initiating performance of the selected one or more intellectual property services, gives just what one would expect from the manual step as shown by BPM. In other words, there is no enhancement found in the claimed step other than the known advantage of increased speed. The end result is the same as compared to the manual method.

8. Therefore, It would have been obvious to a person of ordinary skill in the art at the time of the invention to automate the step of performing the selected one or more intellectual property services, because this would speed up the performance step which is purely known and expected result from automation of what is known in the art.
9. BPM also fails to further show transmitting the proposed transactions to the customer over the Internet and the customer sending back over the Internet a notice either agreeing to the proposed transactions or not.
10. However, Official Notice is given that the advantage of communicating over the Internet for businesses to reach customers anywhere in the world, was well known at the time the invention was made.
11. It would have been obvious to a person of ordinary skill in the art at the time of the invention to transmit the proposed transactions to the customer over the Internet and have the customer send back over the Internet a notice either agreeing to the proposed transactions or not because the advantage of communicating over the Internet allows a service provider to do business with customers anywhere in the world that has access to the Internet.

12. BPM also fails to disclose filing of documents and/or payment of fees relative to one or more target jurisdictions.
13. However, InventNet discloses the registration and selection of one or more target jurisdictions/agents (pg.7-9 and 11).
14. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included one or more target jurisdictions as disclosed by InventNet in the system disclosed by BPM, for the advantage of providing a method of transacting an intellectual property service with the ability to widen customer services capabilities by offering intellectual property services in a multitude of jurisdictions (US and foreign).
15. As per Claim 4, BPM and Invent Net disclose for the one or more particular intellectual property matters: presenting a user with one or more target jurisdictions and one or more respective associates for each of at least a portion of said target jurisdictions, wherein the fees associated with a particular one or ones of the intellectual property services are further particularized by target jurisdiction and/or said one or more respective associates.
16. As per Claim 5, BPM and Invent Net disclose wherein the one or more intellectual property matter is determined responsive to a docket event, further comprising: automatically initiating the providing of information representative of one or more intellectual property services in response to a docket event for a particular intellectual property matter corresponding thereto.
17. As per Claim 6, BPM and Invent Net disclose retrieving information characterizing an intellectual property application corresponding to the one or more intellectual property

matters from a data store; and calculating the associated one or more fees provided to the user, including referring to at least a portion of the intellectual property application information to determine the associated one or more fees.

18. As per Claim 7, BPM and Invent Net disclose supplying information encoding the selected one or more intellectual property services and the associated one or more fees for use in an accounting system.
19. As per Claim 25, BPM and Invent Net disclose transacting, substantially coincident with the performance of the selected one or more intellectual property services, the associated one or more fees.
20. As per Claim 26, BPM and Invent Net disclose transacting, prior to the performance of the selected one or more intellectual property services, the associated one or more fees.
21. As per Claim 27, BPM and Invent Net disclose wherein the one or more intellectual property matters relate to a plurality of jurisdictions, and wherein the information is further particularized by the one or more intellectual property matters.
22. As per Claim 28, BPM and Invent Net disclose retrieving information characterizing an intellectual property application corresponding to the intellectual property matter from a data store; and at least partially completing target jurisdiction- and associate-specific documents for the services from the retrieved information.
23. As per **independent Claim 11**, BPM discloses a method of operating an information service to facilitate fee transaction in connection with the filing of documents and/or payment of fees relating to intellectual property services, the method comprising:
registering an associate, a computer readable encoding of fees for one or more intellectual

property services performed by the associate therein (pgs.10-20); distributing information representative of the jurisdiction, and at least a portion of one or more associates registered therefore and corresponding fees, to a user for use in transacting at least one of the intellectual property services using a respective one or ones of the associates (pgs.10-20).

24. BPM fails to expressly disclose automating the step of performing and transacting at least one of the offered intellectual property services, to include: determining, responsive to selection by the user of one or more specific matters and of one or more of the target jurisdictions and/or associates, matter-specific fees, including referencing the encoding of fees, and providing, to the user, the matter-specific fees.
25. However, BPM discloses an intellectual property information service wherein the website outlines the fees associated with the application process (pgs.10-12) along with an outline of the steps required in the application process, to include an initial consultation, search, and application completion and filing (pgs. 10-12) - and it would have been obvious to one of ordinary skill in the art at the time the invention was made to simple automate this process by completing the outlined steps electronically, to include an electronic consultation (wherein fees and schedules would be reviewed and agreed upon) and by electronically supplying the necessary forms (for completion of the intellectual property application process.
26. Furthermore, It was known at the time the invention was made, that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193,

194 (CCPA 1958). For example, simply automating the performance/transacting of the selected one or more intellectual property services, gives just what one would expect from the manual step as shown by BPM. In other words, there is no enhancement found in the claimed step other than the known advantage of increased speed. The end result is the same as compared to the manual method.

27. Therefore, It would have been obvious to a person of ordinary skill in the art at the time of the invention to automate the step of performing/transacting the selected one or more intellectual property services, because this would speed up the performance step which is purely known and expected result from automation of what is known in the art.
28. BPM also fails to further show transmitting the proposed transactions to the customer over the Internet and the customer sending back over the Internet a notice either agreeing to the proposed transactions or not.
29. However, Official Notice is given that the advantage of communicating over the Internet for businesses to reach customers anywhere in the world, was well known at the time the invention was made.
30. It would have been obvious to a person of ordinary skill in the art at the time of the invention to transmit the proposed transactions to the customer over the Internet and have the customer send back over the Internet a notice either agreeing to the proposed transactions or not because the advantage of communicating over the Internet allows a service provider to do business with customers anywhere in the world that has access to the Internet.

31. BPM also fails to disclose filing of documents and/or payment of fees relative to one or more target jurisdictions, to include registering for each of plural associates, at least one target jurisdiction.
32. However, InventNet discloses the registration and selection of one or more target jurisdictions/agents (pg. 7-9 and 11).
33. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included one or more target jurisdictions as disclosed by InventNet in the system disclosed by BPM, for the advantage of providing a method of transacting an intellectual property service with the ability to widen customer services capabilities by offering intellectual property services in a multitude of jurisdictions (US and foreign).
34. As per Claim 12, BPM and Invent Net disclose wherein the distributing is responsive to selection by the user of one or more of the target jurisdictions and, for each selected target jurisdiction, a respective one or ones of the associates.
35. As per Claim 13, BPM and Invent Net disclose wherein the distributing includes supplying, on a periodic basis, to the user, of the computer readable encoding of fees.
36. As per Claim 29, BPM and Invent Net disclose registering forms, for each of plural associates, for the at least one jurisdiction, for use in directing the filing of documents and/or payment of fees in the jurisdiction, distributing to a user, responsive to selection of respective one or more associates, at least a portion of the respective forms; and responsive to receipt of at least partially completed forms from the user, forwarding the at least partially completed forms to the respective one or more associates.

37. As per **independent Claim 15**, BPM discloses an information system for transacting fees associated with intellectual property services in connection with the filing of documents and/or payment of fees, comprising: an intellectual property service portal, the intellectual property service portal responsive to a selection at the originating node of at least one intellectual property service, supplying the originating node with the information representative of one or more fees corresponding to the selected at least one intellectual property service (pgs.10-20).
38. BPM fails to expressly disclose automating the disclosed step: wherein in response to selection by a user of one or more of the intellectual property services, initiating performance of the selected one or more intellectual property services, and substantially coincident with performance thereof, transacting the associated one or more fees.
39. However, BPM discloses an intellectual property information service wherein the website outlines the fees associated with the application process (pgs.10-12) along with an outline of the steps required in the application process, to include an initial consultation, search, and application completion and filing (pgs. 10-12) - and it would have been obvious to one of ordinary skill in the art at the time the invention was made to simple automate this process by completing the outlined steps electronically, to include an electronic consultation (wherein fees and schedules would be reviewed and agreed upon) and by electronically supplying the necessary forms (for completion of the intellectual property application process.
40. Furthermore, It was known at the time the invention was made, that merely providing an automatic means to replace a manual activity which accomplishes the same result is not

sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example, simply automating the step of initiating performance of the selected one or more intellectual property services, gives just what one would expect from the manual step as shown by BPM. In other words, there is no enhancement found in the claimed step other than the known advantage of increased speed. The end result is the same as compared to the manual method.

41. Therefore, It would have been obvious to a person of ordinary skill in the art at the time of the invention to automate the step of performing the selected one or more intellectual property services, because this would speed up the performance step which is purely known and expected result from automation of what is known in the art.
42. BPM also fails to further show transmitting the proposed transactions to the customer over the Internet and the customer sending back over the Internet a notice either agreeing to the proposed transactions or not.
43. However, Official Notice is given that the advantage of communicating over the Internet for businesses to reach customers anywhere in the world, was well known at the time the invention was made.
44. It would have been obvious to a person of ordinary skill in the art at the time of the invention to transmit the proposed transactions to the customer over the Internet and have the customer send back over the Internet a notice either agreeing to the proposed transactions or not because the advantage of communicating over the Internet allows a service provider to do business with customers anywhere in the world that has access to the Internet.

45. BPM also fails to disclose filing of documents and/or payment of fees relative to one or more target jurisdictions - corresponding to associates licensed or otherwise authorized to perform intellectual property services in one or more target jurisdictions.
46. However, InventNet discloses the registration and selection of one or more target jurisdictions/agents (pg. 7-9 and 11).
47. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included registering one or more target jurisdictions as disclosed by InventNet in the system disclosed by BPM, for the advantage of providing a method of transacting an intellectual property service with the ability to widen customer services capabilities by offering intellectual property services in a multitude of jurisdictions (US and foreign).
48. As per Claim 16, BPM and Invent Net disclose wherein for a particular selected target jurisdiction and associate combination, the one or more fees include: one or more official fees for an intellectual property filing in the particular selected target jurisdiction; and one or more service fees of the selected associate for performing the selected at least one intellectual property service.
49. As per Claim 17, BPM and Invent Net disclose wherein the originating node includes a computer of the managing attorney or intellectual property owner; and wherein the target nodes include computers of respective associates configured to electronically receive at least partial instructions concerning an intellectual property filing from the managing attorney or intellectual property owner via the intellectual property service portal.

50. As per Claim 18, BPM and Invent Net disclose wherein the originating node includes a web browser; wherein the intellectual property service portal includes a web server; wherein the selection of at least one intellectual property service, the supplying of the information representative of one or more fees, and the transacting of the one or more fees are achieved at least in part, using internet protocol traffic between the web browser and the web server.
51. As per Claim 19, BPM and Invent Net disclose wherein the intellectual property filing portal is further responsive to registration by the associates of information representative of one or more fees corresponding to the associate; wherein the supplied information representative of one or more fees include those registered by the selected associates.
52. As per **independent Claim 21**, BPM fails to expressly disclose automating a method (computer program product encoded in a computer readable medium) for translating an intellectual property service in connection with the filing of documents and/or payment of fees, the method: selection code executable to select from amongst one or more intellectual property services supported by one or more information services therefore and to initiate performance of the selected one or more intellectual property service; and fee transaction code executable to transact one or more fees associated with the selected one or more intellectual property services substantially coincident with performance of the one or more intellectual property services by a corresponding one or ones of the information services.
53. However, BPM discloses an intellectual property information service wherein the website outlines the fees associated with the application process (pgs.10-12) along with an outline

of the steps required in the application process, to include an initial consultation, search, and application completion and filing (pgs. 10-12) - and it would have been obvious to one of ordinary skill in the art at the time the invention was made to simple automate this process by completing the outlined steps electronically, to include an electronic consultation (wherein fees and schedules would be reviewed and agreed upon) and by electronically supplying the necessary forms (for completion of the intellectual property application process.

54. Furthermore, It was known at the time the invention was made, that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example, simply automating the step of initiating performance of the selected one or more intellectual property services, gives just what one would expect from the manual step as shown by BPM. In other words, there is no enhancement found in the claimed step other than the known advantage of increased speed. The end result is the same as compared to the manual method.

55. Therefore, It would have been obvious to a person of ordinary skill in the art at the time of the invention to automate the step of performing the selected one or more intellectual property services, because this would speed up the performance step which is purely known and expected result from automation of what is known in the art.

56. BPM also fails to further show transmitting the proposed transactions to the customer over the Internet and the customer sending back over the Internet a notice either agreeing to the proposed transactions or not.

57. However, Official Notice is given that the advantage of communicating over the Internet for businesses to reach customers anywhere in the world, was well known at the time the invention was made.
58. It would have been obvious to a person of ordinary skill in the art at the time of the invention to transmit the proposed transactions to the customer over the Internet and have the customer send back over the Internet a notice either agreeing to the proposed transactions or not because the advantage of communicating over the Internet allows a service provider to do business with customers anywhere in the world that has access to the Internet.
59. BPM also fails to disclose filing of documents and/or payment of fees relative to one or more target jurisdictions.
60. However, InventNet discloses the registration and selection of one or more target jurisdictions/agents (pg.7-9 and 11).
61. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included one or more target jurisdictions as disclosed by InventNet in the system disclosed by BPM, for the advantage of providing a method of transacting an intellectual property service with the ability to widen customer services capabilities by offering intellectual property services in a multitude of jurisdictions (US and foreign).
62. As per Claim 22, BPM and Invent Net disclose wherein the selection code and the fee transaction code are all executable on a same processor.

63. As per Claim 30, BPM and Invent Net disclose instruction code for presenting a user with one or more target jurisdictions and one or more respective associates for each of at least a portion of said target jurisdictions, the one or more fees associates with a particular one or ones of the intellectual property services being further particularized by target jurisdiction and/or said one or more respective associates.
64. As per **independent Claim 24**, BPM fails to expressly disclose automating a method (an intellectual property filing preparation system) in connection with preparing to file documents and/or to pay fees in one or more target jurisdictions, comprising: means for selecting from amongst one or more intellectual property services to be performed in one or more target jurisdictions and for selecting at least one intellectual property matter therefor; means for initiating performance of the selected one or more intellectual property services for the at least one intellectual property matter; and means for transacting fees substantially coincident with the performance of the selected one or more intellectual property services.
65. However, BPM discloses an intellectual property information service wherein the website outlines the fees associated with the application process (pgs.10-12) along with an outline of the steps required in the application process, to include an initial consultation, search, and application completion and filing (pgs. 10-12) - and it would have been obvious to one of ordinary skill in the art at the time the invention was made to simple automate this process by completing the outlined steps electronically, to include an electronic consultation (wherein fees and schedules would be reviewed and agreed upon) and by

electronically supplying the necessary forms (for completion of the intellectual property application process.

66. Furthermore, It was known at the time the invention was made, that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example, simply automating the step of initiating performance of the selected one or more intellectual property services, gives just what one would expect from the manual step as shown by BPM. In other words, there is no enhancement found in the claimed step other than the known advantage of increased speed. The end result is the same as compared to the manual method.
67. Therefore, It would have been obvious to a person of ordinary skill in the art at the time of the invention to automate the step of performing the selected one or more intellectual property services, because this would speed up the performance step which is purely known and expected result from automation of what is known in the art.
68. BPM also fails to further show transmitting the proposed transactions to the customer over the Internet and the customer sending back over the Internet a notice either agreeing to the proposed transactions or not.
69. However, Official Notice is given that the advantage of communicating over the Internet for businesses to reach customers anywhere in the world, was well known at the time the invention was made.
70. It would have been obvious to a person of ordinary skill in the art at the time of the invention to transmit the proposed transactions to the customer over the Internet and have

the customer send back over the Internet a notice either agreeing to the proposed transactions or not because the advantage of communicating over the Internet allows a service provider to do business with customers anywhere in the world that has access to the Internet.

71. BPM also fails to disclose filing of documents and/or payment of fees relative to one or more target jurisdictions.

72. However, InventNet discloses the registration and selection of one or more target jurisdictions/agents (pg.7-9 and 11).

73. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included one or more target jurisdictions as disclosed by InventNet in the system disclosed by BPM, for the advantage of providing a method of transacting an intellectual property service with the ability to widen customer services capabilities by offering intellectual property services in a multitude of jurisdictions (US and foreign).

74. As per **independent Claim 31**, BPM discloses a computer implemented method for transacting an intellectual property service in connection with the filing of documents and/or payment of fees for intellectual property matters, the method comprising: providing a user with information representative of one or more intellectual property matters; providing a user with information representative of one or more intellectual property services corresponding to the one or more particular intellectual property matters, and one or more fees associated therewith, wherein the fees include one or more of: official fees, and service fees; the one or more fees associated with a particular one or

ones of the intellectual property services being particularized by particular intellectual property matter (pgs. 10-20).

75. BPM fails to expressly disclose automating the disclosed step: determining one or more intellectual property matters; providing, responsive to the determination, a user with information representative of one or more intellectual property services corresponding to the one or more particular intellectual property matters, and the associated one or more fees provided to the user being calculated, including retrieving information characterizing an intellectual property application corresponding to the one or more intellectual property matters from a data store and referring to at least a portion of the intellectual property application information to determine the associated one or more fees; selecting, responsive to the user, one or more of the intellectual property services for one or more of the intellectual property matters, and initiating, responsive to the user, performance of the selected one or more intellectual property services for one or more of the intellectual property matters.
76. However, BPM discloses an intellectual property information service wherein the website outlines the fees associated with the application process (pgs.10-12) along with an outline of the steps required in the application process, to include an initial consultation, search, and application completion and filing (pgs. 10-12) - and it would have been obvious to one of ordinary skill in the art at the time the invention was made to simple automate this process by completing the outlined steps electronically, to include an electronic consultation (wherein fees and schedules would be reviewed and agreed upon) and by

electronically supplying the necessary forms (for completion of the intellectual property application process.

77. Furthermore, It was known at the time the invention was made, that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example, simply automating the step of initiating performance of the selected one or more intellectual property services, gives just what one would expect from the manual step as shown by BPM. In other words, there is no enhancement found in the claimed step other than the known advantage of increased speed. The end result is the same as compared to the manual method.
78. Therefore, It would have been obvious to a person of ordinary skill in the art at the time of the invention to automate the step of performing the selected one or more intellectual property services, because this would speed up the performance step which is purely known and expected result from automation of what is known in the art.
79. BPM also fails to further show transmitting the proposed transactions to the customer over the Internet and the customer sending back over the Internet a notice either agreeing to the proposed transactions or not.
80. However, Official Notice is given that the advantage of communicating over the Internet for businesses to reach customers anywhere in the world, was well known at the time the invention was made.
81. It would have been obvious to a person of ordinary skill in the art at the time of the invention to transmit the proposed transactions to the customer over the Internet and have

the customer send back over the Internet a notice either agreeing to the proposed transactions or not because the advantage of communicating over the Internet allows a service provider to do business with customers anywhere in the world that has access to the Internet.

82. BPM also fails to disclose filing of documents and/or payment of fees relative to one or more target jurisdictions / target associates.

83. However, InventNet discloses the registration and selection of one or more target jurisdictions/agents (pg.7-9 and 11).

84. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included one or more target jurisdictions / target associates as disclosed by InventNet in the system disclosed by BPM, for the advantage of providing a method of transacting an intellectual property service with the ability to widen customer services capabilities by offering intellectual property services in a multitude of jurisdictions (US and foreign).

85. As per **independent Claim 32**, BPM disclose a computer program product encoded in a computer readable medium for translating an intellectual property service in connection with the filing of documents and/or payment of fees, the computer program product comprising: code executable to provide information regarding one or more intellectual property services supported by one or more information services therefore (pgs. 10-20).

86. BPM fails to expressly disclose automating the disclosed step: the selection of one or more intellectual property services corresponding to the one or more particular intellectual property matters, and to initiate performance of the selected one or more

intellectual property services relative to one or more particular intellectual property matters; fee transaction code executable to transact one or more fees associated with the selected one or more intellectual property services and one or more particular intellectual property matters substantially coincident with performance of the one or more intellectual property services by a corresponding one or ones of the information services; the one or more fees associates with a particular one or ones of the intellectual property services being further particularized by one or more particular intellectual property matters.

87. However, BPM discloses an intellectual property information service wherein the website outlines the fees associated with the application process (pgs.10-12) along with an outline of the steps required in the application process, to include an initial consultation, search, and application completion and filing (pgs. 10-12) - and it would have been obvious to one of ordinary skill in the art at the time the invention was made to simple automate this process by completing the outlined steps electronically, to include an electronic consultation (wherein fees and schedules would be reviewed and agreed upon) and by electronically supplying the necessary forms (for completion of the intellectual property application process.

88. Furthermore, It was known at the time the invention was made, that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example, simply automating the step of initiating performance of the selected one or more intellectual property services, gives just what one would expect from the manual step as shown by BPM. In other words, there is no enhancement found

in the claimed step other than the known advantage of increased speed. The end result is the same as compared to the manual method.

89. Therefore, It would have been obvious to a person of ordinary skill in the art at the time of the invention to automate the step of performing the selected one or more intellectual property services, because this would speed up the performance step which is purely known and expected result from automation of what is known in the art.
90. BPM also fails to further show transmitting the proposed transactions to the customer over the Internet and the customer sending back over the Internet a notice either agreeing to the proposed transactions or not.
91. However, Official Notice is given that the advantage of communicating over the Internet for businesses to reach customers anywhere in the world, was well known at the time the invention was made.
92. It would have been obvious to a person of ordinary skill in the art at the time of the invention to transmit the proposed transactions to the customer over the Internet and have the customer send back over the Internet a notice either agreeing to the proposed transactions or not because the advantage of communicating over the Internet allows a service provider to do business with customers anywhere in the world that has access to the Internet.
93. BPM also fails to disclose filing of documents and/or payment of fees relative to one or more target jurisdictions / target associates.
94. However, InventNet discloses the registration and selection of one or more target jurisdictions/agents (pg. 7-9 and 11).

95. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included one or more target jurisdictions / target associates as disclosed by InventNet in the system disclosed by BPM, for the advantage of providing a method of transacting an intellectual property service with the ability to widen customer services capabilities by offering intellectual property services in a multitude of jurisdictions (US and foreign).

96. **Claims 2, 3, 14, 20, and 23 are rejected under 35 U.S.C. 103 as being unpatentable over BPM in view of InventNet.**

97. As per Claim 2, BPM and InventNet does not expressly show wherein the intellectual property services include one or more of paying an annuity of maintenance fee, making an intellectual property filing on behalf of the user, and preparing and/or filing target jurisdiction-specific and associate-specific form documents for directing and or effecting the filing and/or payment thereof.

98. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The intellectual property service transaction system would be performed regardless of the type of intellectual property service offered. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

99. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to offer intellectual property services to include one or more of

paying an annuity of maintenance fee, making an intellectual property filing on behalf of the user, and preparing and/or filing target jurisdiction-specific and associate-specific form documents for directing and or effecting the filing and/or payment thereof, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

100. As per Claim 3, BPM and InventNet does not expressly show substantially coincident with the performance, transacting the associated one or more fees, wherein the fee transacting includes one or more of authorizing a debit of deposit account, supplying an invoice, and processing the fee via a payment system.

101. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The intellectual property service transaction system would be performed regardless of the type of transaction used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

102. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to complete the system transaction by authorizing a debit of deposit account, supplying an invoice, and processing the fee via a payment system, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

103. As per Claims 14 and 23, BPM and InventNet does not expressly show wherein the distributing is encoded by or transmitted in at least one computer readable medium selected from the set of a disk, CD-ROM, tape or other magnetic, optical, or electronic storage medium in a network, wire line, wireless or other communications medium.
104. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The intellectual property service transaction system would be performed regardless of how the information is encoded/transmitted. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
105. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to encode/transmit the information in at least one computer readable medium selected from the set of a disk, CD-ROM, tape or other magnetic, optical, or electronic storage medium in a network, wire line, wireless or other communications medium, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.
106. As per Claim 20, BPM and InventNet does not expressly show wherein the network includes one or more of a packet switched network segment, a circuit switched network segment, a public network segment, a private network segment, a public switched telecommunications network segment, and a virtual private network.

107. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The intellectual property service transaction system would be performed regardless of what the network includes. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
108. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include one or more of a packet switched network segment, a circuit switched network segment, a public network segment, a private network segment, a public switched telecommunications network segment, and a virtual private network, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Response to Arguments

109. Applicant's arguments with respect to Claims 1-7 and 11-32 have been considered but are not persuasive. The rejection will remain as final based on the cited prior art.
110. The applicant makes the argument that the prior art of BPM in view of InventNet fails to disclose: determining at least one intellectual property matter, providing information on service corresponding to a particular intellectual property matter, a selectable intellectual property matter or service, or action respondent to the selection of a intellectual property matter or service.


111. Furthermore, the applicant makes the argument that the prior art of BPM in view of InventNet fails to disclose the possibility of particular intellectual property matters, that service can be provided with respect to particular intellectual property matters, and that matters may cover more than one target jurisdiction.
112. Finally, the applicant makes numerous arguments that the prior art of BPM in view of InventNet fails to disclose common business practices involved in handling intellectual property matters – to include selecting matters/services and handling transaction fees.
113. However, the method described by BPM in view of InventNet discloses multiple tools for an inventor to pursue intellectual property protection on an invention/inventive concept. The tools include the ability to select the type of intellectual property protection required (matters), the ability to select several different available services regarding the different areas of intellectual property protection (constructing an application, filing a application, maintaining the protection), and the ability of an inventor to select a jurisdiction (international and national) for assistance in obtaining intellectual property protection. The fact that the prior art fails to explicitly disclose specific well-known/inherent business techniques, such as selection of the matter or service, completing a transaction, or selecting a jurisdiction or use the automation described in the instant invention of the applicant is moot. As described in the rejection above, the incorporation of such business techniques (automated or manually) would have been obvious to one of ordinary skill in the art at the time the invention was made, as part of

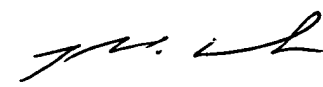
Art Unit: 3629

doing business using the information provided on the linked web pages of BPM and InventNet.

Conclusion

114. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (703) 605-0662. The examiner can normally be reached on Monday through Friday, 8am - 4:30pm.
115. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-3597 for After Final communications.
116. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.


jo
January 13, 2005


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